



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839

26158 7590 12/30/2004

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC  
P.O. BOX 7037  
ATLANTA, GA 30357-0037

EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/759,103

**Applicant(s)**

CLARK ET AL

**Examiner**

DANIEL LASTRA

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-30 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

#### ***Response to Amendment***

2. In response to Final Rejection filed 06/22/04, the Applicant filed an RCE, amended claims 1-4, 10, 11, 15, 16 and added new claims 20-30. Applicant amendment overcame the Section 112 rejection of claim 10.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 15 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recites "providing the user with an option to play a game to win a selected product or service without first making any payment". The claims are indefinite because the claims do not explain who is the entity that is not first making any payment. For purpose of art rejection, the Examiner interprets the claims that the user is the one that is not first making any payment.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (U.S. 2003/0054888) in view of Ghouri et al (U.S. 2002/0082978).

As per claim 10, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter descriptive of a product (see paragraph 39);

transmitting electronic signals representing at a least one product, a price of the product (see paragraph 39) Walker fails to teach and a third-party dealer of the product. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of the different dealers of users' selected products, which users would like to play games to win the products. This feature would show to users the best dealers' offers of products selected by users.

Walker teaches:

transmitting electronic signals representing at least a first option *for the user* to play a game to win the product *without first making any payment* (see paragraph 130), and a second option to purchase the product (see paragraph 149);

if the user *chooses* to play the game:

Art Unit: 3622

electronically calculating a probability of winning the product *by the user*,  
electronically generating a pseudo-random outcome corresponding to the calculated  
probability of *winning* (see paragraph 144); and

*in response to a winning* pseudo-random outcome, purchasing the product for  
the user (see paragraph 145);

and

if the user *chooses* to purchase the product *instead of playing the game*:

directing the user to a web site *which sells the product* (see paragraph 149-151);

As per claim 12, Walker and Ghouri teach:

The method of claim 10, comprising calculating a probability of winning based on  
at least a current budget (see Walker paragraph 144).

As per claim 13, Walker and Ghouri teach:

The method of claim 10, comprising calculating a probability P of winning based  
on a total number of game players (see Walker paragraph 110).

As per claim 14, Walker and Ghouri teach:

The method of claim 10, comprising calculating a probability P of winning based  
on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the  
cost of the selected product in relation to the total cost of all products available.  
However, it would have been obvious to a person of ordinary skill in the art at the time

the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see paragraph 143).

$P_t$  is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

$P_u$  is probability factor that varies with the user's behavior (see Walker paragraph 88); and

$N$  is a number of current users (see Walker paragraph 110).

Claim 15 contains the same limitation as claim 10 therefore the same rejection is applied.

Claim 17 contains the same limitation as claim 12 therefore the same rejection is applied.

Claim 18 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim 19 contains the same limitation as claim 14 therefore the same rejection is applied.

As per claim 20, Walker and Ghouri teach:

The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices

Art Unit: 3622

charged on said each of said different dealers' own web sites (see Ghouri figure 20).

Therefore, the same rejection applied to claim 10 is applied to claim 20.

As per claim 21, Walker and Ghouri teach:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter descriptive of a product;

searching for products matching said at least one search parameter, transmitting electronic signals representing a plurality of dealers and associated prices charged by each of said dealers for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each dealer;

transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without first making any payment; and

if the user chooses to play the game:

electronically calculating a probability of winning said selected one product by the user, electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding dealer for the user. The same rejection applied to claim 10 is applied to claim 21.

As per claim 22, Walker and Ghouri teach:

A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service; conducting a search in a database for a product or service that satisfies the search query; presenting a result of the search to the user, including at least one product or service retrieved from the database;

enabling the user to select the product or service that he wants to win;  
determining the user's chance of winning the selected product or service;  
generating an outcome for each play of the game that corresponds to the user's chance of winning; and

displaying the outcome of the game to the user. The same rejection applied to claim 10 is applied to claim 22.

As per claim 23, Walker and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 24, Walker and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of



Art Unit: 3622

winning the selected product or service through repeated plays of the game. The same rejection applied to claim 2 is applied to claim 24.

As per claim 25, Walker and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor. The same rejection applied to claims 7-8 is applied to claim 25.

As per claim 27, Walker and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game. The same rejection applied to claim 2 is applied to claim 27.

Claim 1 contains the same limitations as claim 10 therefore the same rejection is applied.

As per claim 2, Walker and Ghouri teach:

The method of claim 1, wherein the probability *of winning on successive plays of the game increases* with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

Claim 7 contains the same limitation as claim 12 therefore the same rejection is applied.

Claim 8 contains the same limitation as claim 13 therefore the same rejection is applied.

Claim 9 contains the same limitation as claim 14 therefore the same rejection is applied.

Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri et al (U.S. 2002/0082978) and in further view of Yoseloff (U.S. 6,331,143).

As per claim 3, Walker and Ghouri teach:

The method of claim 1, wherein the *pseudo-random* outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker and Ghouri system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as

customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker, Yoseloff and Ghouri teach:

The method of claim 3, wherein an increased probability of winning *on successive plays of the game* is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker, Yoseloff and Ghouri teach:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with

Art Unit: 3622

customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

As per claim 29, Walker, Yoseloff and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises matching a number selected by the user with the number generated as the outcome for each play of the game. The same rejection applied to claim 3 is applied to claim 29.

Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri et al (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811).

As per claim 11, Walker and Ghouri teach:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning *on successive plays of the game* by performing a task for which a third party provides compensation. However, Angles

Art Unit: 3622

teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

Claim 6 contains the same limitation as claim 11 therefore the same rejection is applied.

Claim 16 contains the same limitation as claim 11 therefore the same rejection is applied.

As per claim 26, Walker, Angles and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service as a payment for a display of an advertisement to the user during each play of the game. The same rejection applied to claim 11 is applied to claim 26.

As per claim 28, Walker, Angles and Ghouri teach:

The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor for a game provider which increases the user's chance of winning the selected product or service. The same rejection applied to claim 11 is applied to claim 28.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri et al (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker, Yoseloff and Ghouri teach

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can reduce a number of digits that must be matched in order to win the product or service by participating in an online survey for an advertising sponsor. The same rejection applied to claim 11 is applied to claim 30. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

### ***Conclusion***

5. The Examiner uses Walker (2003/0054888) as prior art, which claims priority to provisional application 60/204,673 filed on May 17, 2000. Provisional Application

Art Unit: 3622

60/204,673 teaches in page 6 that a customer may be able to play games to win products without first making any payment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
December 22, 2004

*Yeholega Della*  
Primary Examiner  
AU 3622